

REMARKS

Summary of the Examiner's Actions

The Examiner rejected Claims 2, 3, 8, 13, 14, 17, 18, 21, and 22 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter that Applicant regards as the invention. Applicant acknowledges the rejection under 35 U.S.C. § 112, second paragraph.

The Examiner rejected Claims 3, 14, 18, and 22 under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement. Applicant acknowledges the rejection under 35 U.S.C. § 112, first paragraph.

The Examiner rejected Claims 1, 5, 6, 11, 15, and 19 under 35 U.S.C. § 103(a) as being unpatentable over Bayne, U.S. Patent Number 7,158,621 (“Bayne”). Applicant acknowledges the rejection under 35 U.S.C. § 103(a).

The Examiner rejected Claims 7 and 10 under 35 U.S.C. § 103(a) as being unpatentable over Bayne in view of Brawn et al., U.S. Patent Number 6,665,379 (“Brawn”), and further in view of Pendse, U.S. Patent Number 6,298,056 (“Pendse”). Applicant acknowledges the rejection under 35 U.S.C. § 103(a).

The Examiner rejected Claims 8 and 9 under 35 U.S.C. § 103(a) as being unpatentable over Bayne in view of Pendse. Applicant acknowledges the rejection under 35 U.S.C. § 103(a).

The Examiner rejected Claims 2, 3, 13, 14, 17, 18, 21, and 22 under 35 U.S.C. § 103(a) as being unpatentable over Bayne in view of Brawn. Applicant acknowledges the rejection under 35 U.S.C. § 103(a).

The Examiner rejected Claims 4, 12, 16, and 20 under 35 U.S.C. § 103(a) as being unpatentable over Bayne in view of Pendse. Applicant acknowledges the rejection under 35 U.S.C. § 103(a).

Rejections under 35 U.S.C. § 112, second paragraph

The Examiner rejected Claims 2, 3, 8, 13, 14, 17, 18, 21, and 22 under 35 U.S.C. § 112, second paragraph, stating:

Claims 2, 13, 17 and 21 recite the limitation of: *wherein said process further includes reading a plurality of user information*. It is unclear how the process read the user information. Appropriate correction and/or clarification is required.

Claims 3, 14, 18 and 22 recite the limitation of: *wherein said process further includes a user customizing said advertisement*. It is unclear how user customizes the advertisement, since the advertisement is already selected. Appropriate correction and /or clarification is required.

Claim 8 recites the limitation of: *a means for routing an unanswered telephone call from a caller to a user*. It is unclear how the unanswered telephone call is routed from a caller to a user. Appropriate correction and/or clarification is required. For the purpose of this examination, Examiner interprets the above limitation as routing the unanswered call from a caller to a server. Claim 8 contradicts with claim 1 of applicant's invention, where the call is routed to a server not a user.

Paper Number 20071225, pg 2.

Applicant submits that the limitation “wherein said process further includes reading a plurality of user information” is clearly supported in the specification of the above-referenced patent application. More specifically, at paragraph [0020], the specification states that “[t]he voice mail server **104** runs a routine to read the user data **302**. The user data includes information on the advertisements selected by the user **112** for playback.” Additionally, at paragraph [0018], the specification states that “[t]he voice mail server **104** ... should also be broadly construed to mean any computer or component thereof that executes software”. Therefore, it is clear that because the user information is stored at the voice mail server, the user information is digitally stored and is read as the digitally recorded voice mails and messages, which are also stored at the voice mail server, are read. Accordingly, Applicant submits that the specification clearly supports how the system of Claims 2, 13, 17, and 21 reads the user information. Considering Applicant’s above-discussion, Applicant respectfully submits that the

Examiner's rejection of Claims 2, 13, 17 and 21 under 35 U.S.C. § 112, second paragraph, has been overcome and respectfully requests reconsideration and allowance of Claims 2, 13, 17 and 21.

Applicant also submits that the limitation "wherein said process further includes a user customizing said advertisement" is clearly supported in the specification of the above-referenced patent application. More specifically, at paragraph [0026], the specification states that "[i]ncluded in the database are custom tag phrases that the user **112** can incorporate into the advertisements going out to the caller **114**, for example, the user's name or company title." Additionally, at paragraph [0021], the specification states: "For example, one advertisement message states, 'Remember to use XYZ for your Internet search engine, and leave Jason a message.' In this example, the name of the user **112** is part of the advertising message." Consequently, Applicant submits that the specification clearly supports how the user customizes the advertisement when the advertisement is also selected. Considering Applicant's above-discussion, Applicant respectfully submits that the Examiner's rejection of Claims 3, 14, 18, and 22 under 35 U.S.C. § 112, second paragraph, has been overcome and respectfully requests reconsideration and allowance of Claims 3, 14, 18, and 22.

Rejections under 35 U.S.C. § 112, first paragraph

The Examiner rejected Claims 3, 14, 18, and 22 under 35 U.S.C. § 112, first paragraph, stating:

Claims 3, 14, 18 and 22 recite the limitation of: *wherein said process further includes a user customizing said advertisement*. The specification teaches "the system checks to see if the user has subscribed to voice mail advertising. If the user has not, an outgoing message is played for the caller and the caller's incoming message". The specification does not teach that the user customize the advertisement.

Paper Number 20071225, pg 2-3.

Applicant submits that the specification of the above-referenced patent application teaches that the user is able to customize the advertisement in such a way as to enable one skilled in the art to do so. More specifically, at paragraph [0026], the specification states that

“[i]ncluded in the database are custom tag phrases that the user **112** can incorporate into the advertisements going out to the caller **114**, for example, the user's name or company title.” Additionally, at paragraph [0021], the specification states: “For example, one advertisement message states, ‘Remember to use XYZ for your Internet search engine, and leave Jason a message.’ In this example, the name of the user **112** is part of the advertising message.” Consequently, the specification teaches that the user can customize the advertisement. Considering Applicant’s above-discussion, Applicant respectfully submits that the Examiner’s rejection of Claims 3, 14, 18, and 22 under 35 U.S.C. § 112, first paragraph, has been overcome and respectfully requests reconsideration and allowance of Claims 3, 14, 18, and 22.

Rejections under 35 U.S.C. § 103(a)

The Law of Obviousness

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

35 U.S.C. §103(a).

As discussed at MPEP § 2142, “[t]he examiner bears the initial burden of factually supporting any prima facie conclusion of obviousness. If the examiner does not produce a prima facie case, the applicant is under no obligation to submit evidence of nonobviousness.” When considering obviousness of a combination of known elements, the operative question is thus “whether the improvement is more than the predictable use of prior art elements according to their established functions.” *KSR International Co. v. Teleflex Inc. (KSR)*, 550 U.S., 82 USPQ2d 1385 (2007). As discussed at MPEP § 2141, “[t]he framework for the objective analysis for determining obviousness under 35 U.S.C. 103 is stated in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966). Obviousness is a question of law based on underlying factual inquiries. The factual inquiries enunciated by the Court are as follows: (A) Ascertaining the differences between the claimed invention and the prior art; and (B) Ascertaining the differences

between the claimed invention and the prior art; and (C) Resolving the level of ordinary skill in the pertinent art.”

MPEP § 2141 also states that “[i]t must be remembered that while the ultimate determination of obviousness is a legal conclusion, the underlying *Graham* inquiries are factual. When making an obviousness rejection, Office personnel must therefore ensure that the written record includes findings of fact concerning the state of the art and the teachings of the references applied. In certain circumstances, it may also be important to include explicit findings as to how a person of ordinary skill would have understood prior art teachings, or what a person of ordinary skill would have known or could have done. Factual findings made by Office personnel are the necessary underpinnings to establish obviousness.”

MPEP § 2141 also states that “[o]nce the findings of fact are articulated, Office personnel must provide an explanation to support an obviousness rejection under 35 U.S.C. 103. [R]ationales that may support a conclusion of obviousness include:

(A) Combining prior art elements according to known methods to yield predictable results;

(B) Simple substitution of one known element for another to obtain predictable results;

(C) Use of known technique to improve similar devices (methods, or products) in the same way;

(D) Applying a known technique to a known device (method, or product) ready for improvement to yield predictable results;

(E) “Obvious to try” – choosing from a finite number of identified, predictable solutions, with a reasonable expectation of success;

(F) Known work in one field of endeavor may prompt variations of it for use in either the same field or a different one based on design incentives or other market forces if the variations are predictable to one of ordinary skill in the art;

(G) Some teaching, suggestion, or motivation in the prior art that would have led one of ordinary skill to modify the prior art reference or to combine prior art reference teachings to arrive at the claimed invention.

The Examiner's Rejection

The Examiner rejected Claims 1, 5, 6, 11, 15, and 19 under U.S.C. § 103(a) stating:

Claims 1, 11, 15 and 19:

Bayne discloses:

- *selecting an advertisement for playback* (see at least column 3, lines 44-47);
- *playing said advertisement to a caller* (see at least column 9, lines 59-60);
- *billing an advertiser if said caller did not terminate playback of said advertisement* (see at least column 5, lines 17-19); *and*

Bayne does not specifically disclose:

- *determining whether said caller terminated playback of said advertisement*. However, in at least column 10, lines 45-49, Bayne discloses that the caller may desire to terminate or quit the present call. Therefore, it would be obvious, at the time of the invention, to a person of ordinary skill in the art to conclude that Bayne has disclosed applicant's invention of determining caller terminated playback of the advertisement by determining if the caller quit or terminate the present call, which is equivalent to applicant's invention.

Claims 5 and 6:

Bayne discloses the limitations as shown above.

Bayne further discloses:

- *a telephone router for routing an unanswered telephone call to said at least one server* (see at least column 11, lines 36-48).

- *a telephone router for routing an unanswered telephone call. to said at least one server, said unanswered telephone call being directed originally to a cellular telephone user (see at least column 4, lines 7-8).*

Paper Number 20071225, pg 3-4.

The Examiner rejected Claims 7 and 10 under U.S.C. § 103(a) stating:

Claims 7 and 10:

Bayne discloses:

- *a telephone router for routing an unanswered telephone call to said at least one server (see at least column 11, lines 36-48), said unanswered telephone call being originally directed to a cellular telephone use (see at least column 4, lines 7- 8);*
- *a storage component for advertisements and messages (see at least column 5, lines 13-1 6);*
- *an input/output component for communicating with said telephone router (see at least column 6, lines 1-1 7);*
- *selecting an advertisement for playback (see at least column 3, lines 44-47), playing said advertisement to a caller (see at least column 9, lines 59-60);*
- *billing an advertiser if said caller did not terminate playback including charging said advertiser an advertiser fee (see at least column 5, lines 17-1 9);*

Bayne does not specifically disclose:

- *determining whether said caller terminated playback of said advertisement, However, in at least column 10, lines 45-49, Bayne discloses that the caller may desire to terminate or quit the present call. Therefore, it would be obvious, at the time of the invention, to a person skill in the arts to conclude that Bayne has disclosed applicant's invention of determining caller terminated playback of the advertisement by determining if the caller*

quit or terminate the present call, which is equivalent to applicant's invention.

Bayne does not, but Pendse, however does disclose:

- *crediting a user account* (see at least column 2, lines 61-67). It would have been obvious to one of ordinary skill in the art at the time of the invention to combine Bayne's advertising incoming and voice messaging calls with Pende's crediting subscriber of telephony service facilitation with the motivation of enhancing user experience and increasing telephone service providers' profitability and marketability.

Bayne does not, but Brown, however does disclose:

- *reading a plurality of user customized said advertisement information* (see at least column 1 1, lines 26-47); It would have been obvious to one of ordinary skill in the art at the time of the invention to combine Bayne's advertising incoming and voice messaging calls with Brawn's targeting advertisement to voice messaging system based consumers information with the motivation of providing consumers with preference to customize their voice mail system in order to tailor the function of the system to their desired preferences.

Paper Number 20071225, pg 4-5.

The Examiner rejected Claims 8 and 9 under U.S.C. § 103(a) stating:

Claim 8:

Bayne discloses:

- *a means for routing an unanswered telephone call from a caller to a user* see at least column 1 1, lines 36-48);
- *a means for playing an advertisement for said caller; a means for billing an advertiser for playing said advertisement* (see at least column 9, lines 59-60); *and*
- *a means for receiving a message from said caller* (see at least column 14, lines 30-31).

Bayne does not, but Pendse, however does disclose:

- *a means for crediting said user account* (see at least column 2, lines 61-67). It would have been obvious to one of ordinary skill in the art at the time of the invention to combine Bayne's advertising incoming and voice messaging calls with Pendse's crediting subscriber of telephony service facilitation with the motivation of enhancing user experience and increasing telephone service providers' profitability and marketability.

Claim 9:

Bayne discloses the limitations as shown above.

Bayne further discloses:

- *wherein said user is a cellular telephone user* (see at least column 4, lines 7-8).

Paper Number 20071225, pg 5-6.

The Examiner rejected Claims 2, 3, 13, 14, 17, 18, 21, and 22 under U.S.C. § 103(a) stating:

Claims 2, 3, 13, 14, 17, 18, 21 and 22:

Bayne discloses the limitations as shown above.

Bayne does not, but Brown however does disclose:

- *wherein said process further includes reading a plurality of user information* (see at least column 11, lines 26-47);
- *a user customized said advertisement* (see at least column 11, lines 26-47); It would have been obvious to one of ordinary skill in the art at the time of the invention to combine Bayne's advertising incoming and voice messaging calls with Brown's targeting advertisement to voice messaging system based consumers information with the motivation of providing consumers with preference to customize their voice mail system in order to tailor the function of the system to their desired preferences.

The Examiner rejected Claims 4, 12, 16, and 20 under U.S.C. § 103(a) stating:

Claims 4, 12, 16 and 20:

Bayne discloses the limitations as shown above.

Bayne discloses:

- *billing said advertiser includes charging said advertiser an advertiser fee (see at least column 5, lines 17-19) and*

Bayne does not, but Pendse, however does disclose:

- *crediting a user account (see at least column 2, lines 61-67). It would have been obvious to one of ordinary skill in the art at the time of the invention to combine Bayne's advertising incoming and voice messaging calls with Pendse's crediting subscriber of telephony service facilitation with the motivation of enhancing user experience and increasing telephone service providers' profitability and marketability.*

Applicant's Response

Considering the Examiner's rejection under 35 U.S.C. § 103(a), Applicant concludes that the Examiner relied on the rationale that "[s]ome teaching, suggestion, or motivation in the prior art [] would have led one of ordinary skill to modify the prior art reference or to combine prior art reference teachings to arrive at the claimed invention" ("the TSM rationale") to support the Examiner's 35 U.S.C. § 103(a) rejection. Under the TSM rationale, the Examiner must articulate "a finding that there was some teaching, suggestion, or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings;" and "a finding that there was reasonable expectation of success". *MPEP* § 2143. Additionally, the modified reference or the combined references must arrive at the claimed invention, that is, must include all the claimed limitations of the claimed invention. *MPEP* § 2143.

Applicant amends Claim 1 to read, in pertinent part, “billing an advertiser only if said caller did not terminate playback of said advertisement”. Accordingly, Applicant submits that Bayne, modified as indicated by the Examiner, does not include all the claimed limitations of amended Claim 1. More specifically, Applicant submits that the modified Bayne does not include the step of “determining whether said caller terminated playback of said advertisement” or the step of “billing an advertiser only if said caller did not terminate playback of said advertisement” of amended Claim 1. The step of “determining whether said caller terminated playback of said advertisement” in conjunction with the step of “billing an advertiser only if said caller did not terminate playback of said advertisement” provides the system of amended Claim 1 with the feature of selectively billing the advertiser only when the system determines that the advertisement has been effectively presented to the caller, that is, when the advertisement has been played in its entirety without being terminated by the caller. Stated differently, the system of amended Claim 1 does not bill the advertiser when, for example, the caller is presented with only an insignificant portion of the advertisement before the caller terminates the playback. This feature provides the system of amended Claim 1 with a billing scheme that is more reasonable to the advertiser.

Conversely, the method of Bayne teaches that a “billing module **123** may provide functionality for generating bills for advertisers, who may be charged each time their advertisement is played or on a flat fee basis”. *Bayne*, col. 5, lines 17-19. Stated differently, when the billing module of Bayne charges advertisers based on the number of times the advertisement is played, it charges the advertisers whether the advertisement is played in its entirety or only in part. Therefore, the advertisers are charged for the playing of the advertisement even when a caller is presented with only an insignificant portion of the advertisement. Consequently, the method of Bayne does not include the step of “billing an advertiser only if said caller did not terminate playback of said advertisement”. Additionally, Bayne teaches a determination “as to whether the inmate desires to use the call processing center **106** to access the voice mail system or to place an out-going call or whether the inmate desires to terminate or ‘quit’ the present call”. *Bayne*, col. 10, lines 45-49. However, Bayne does not teach determining whether the playback of the advertisement was terminated. This distinction is supported by the fact that the method of Bayne does use the occurrence of the termination of the playback of the advertisement for any purpose, such as for billing purposes. Even more, Bayne

teaches that “[i]f the inmate chooses to quit, the exemplary method ends”. *Bayne*, col. 10, lines 50-51. Therefore, Bayne does teach a determination as to whether a telephone call is terminated but does not teach a determination as to whether a playback of an advertisement is terminated. Consequently, Bayne does not include the step of “determining whether said caller terminated playback of said advertisement”. Because Bayne does not include the step of “determining” or the step of “billing” of amended Claim 1, Bayne does not include all the limitations of amended Claim 1 and, therefore, does not arrive at the invention of amended Claim 1.

Considering Applicant’s above-discussion, Applicant respectfully submits that the Examiner’s rejection of Claim 1 under 35 U.S.C. § 103(a) has been overcome and respectfully requests reconsideration and allowance of Claim 1.

Considering the above-discussion, Applicant respectfully submits that the Examiner’s rejection of dependent Claims 2-6 under 35 U.S.C. § 103(a) has been overcome because the rejection of the underlying base claim, namely Claim 1, has been overcome. Consequently, Applicant respectfully requests that the Examiner reconsider and allow dependent Claims 2-6.

Applicant amends Claims 11, 15, and 19 to respectively read, in pertinent part, “billing an advertiser only if said caller did not terminate playback”. Considering Applicant’s amendment to Claims 11, 15, and 19, Applicant respectfully submits that the Examiner’s rejection of Claims 11, 15 and 19 under 35 U.S.C. § 103(a) has been overcome for the reasons presented in Applicant’s Response to the Examiner’s rejection of Claim 1 under 35 U.S.C. § 103(a). Consequently, Applicant respectfully requests reconsideration and allowance of Claims 11, 15 and 19.

Considering the above-discussion, Applicant respectfully submits that the Examiner’s rejection of dependent Claims 12-14, 16-18 and 20-22 under 35 U.S.C. § 103(a) has been overcome because the rejection of the underlying base claims, namely Claims 11, 15 and 19, respectively, has been overcome. Consequently, Applicant respectfully requests that the Examiner reconsider and allow dependent Claims 12-14, 16-18 and 20-22.

Applicant amends Claims 7 and 10 to respectively read, in pertinent part, “billing an advertiser only if said caller did not terminate playback, including charging said advertiser an

advertiser fee and crediting a user a portion of said advertiser fee”. Considering Applicant’s amendment to Claims 7 and 10, Applicant respectfully submits that the Examiner’s rejection of Claims 7 and 10 under 35 U.S.C. § 103(a) has been overcome for the reasons presented in Applicant’s Response to the Examiner’s rejection of Claim 1 under 35 U.S.C. § 103(a). Consequently, Applicant respectfully requests reconsideration and allowance of Claims 7 and 10.

Summary

In view of Applicant’s amendment to Claims 1, 7, 10, 11, 15, and 19, cancellation of Claims 8 and 9, and arguments presented herein, Applicant submits that the above-identified patent application is in condition for the issuance of a Notice of Allowance. Such action by the Examiner is respectfully requested. If, however, the Examiner is of the opinion that the application is not in condition for the issuance of a Notice of Allowance, Applicant would appreciate if the Examiner will telephone the undersigned to expedite the prosecution of the application.

The Commissioner is authorized to charge any additional fees associated with this communication, or credit any overpayment, to Deposit Account No. 16-1910 (29351.00).

Respectfully submitted,

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